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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,775	02/27/2004	Serge Bourbonnais	SVL920040007US1 3051P	1899

29141 7590 12/22/2006  
SAWYER LAW GROUP LLP  
P O BOX 51418  
PALO ALTO, CA 94303

EXAMINER
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GOFMAN, ALEX N

ART UNIT	PAPER NUMBER
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2169

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/789,775

Applicant(s)

BOURBONNAIS ET AL.

Examiner

Alex Gofman

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This is the initial Office action based on the application filed on February 27, 2004. **Claims 1-33** are currently pending and have been considered below.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 14, and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 14, and 27 (and their dependent claims, where applicable) contain conditional statements. If the conditional statements are not met, the embodiments of the claims do not produce a concrete, useful or tangible result. Rather, the only results produced would be determination steps and those are non-tangible results. (For example, the claim states that if the "if" condition is met, a result occurs. However, the claim does not address what happens when the "if" condition is not met. In it's current state, it seems the operations described would just hang since it has no alternate to the "if" condition.) In addition to the conditional statements, the claim would still not produce a tangible result since for a result to be tangible, it must be more than just a thought for a computation; it must have real-world value rather than an abstract result. See *GOTTSCALK, Comr. Pats. V. BENSON et al* (US SupCT) 175 USPQ 673 at 676-77 (invention ineligible because it had "no substantial practical application"). For instance, an additional step that includes either storing the result or displaying the result to the user would constitute a tangible result.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 14, and 27 (and their dependent claims, where applicable) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims state that it is "examining completed transaction messages," yet there's not step to make the message complete. The previous steps are examining dependencies of an incomplete message. There is no transition from an incomplete message to a complete one. Thus the claim is not searchable since it is not complete. Moreover, the Claim starts by talking about message (singular) and then proceeds to talk about messages (plural).

4. Claim 14 (and its dependent claims, where applicable) recites the limitation "computer readable medium." There is insufficient antecedent basis for this limitation in the claim since the specification does not provide any basis for a computer readable medium.

In view of the rejections made for claim(s) being indefinite (under 35 U.S.C. 112, second paragraph), as well as the rejections for claims not producing tangible, concrete, and useful results (under 35 U.S.C. 101), the Examiner cannot clearly interpret the claims of the instant Application in order to conduct a useful and effective search. The claims of the instant Application are therefore, considered unsearchable for prior art. The claims must be amended to overcome the above referenced rejections, upon which the Examiner will conduct the appropriate search for prior art.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex Gofman whose telephone number is (571)270-1072. The examiner can normally be reached on Mon-Fri 9am-3pm EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on (571)272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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